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REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-20 are pending in the application. Applicant thanks the Office for its careful and detailed analysis in the current Office Action.

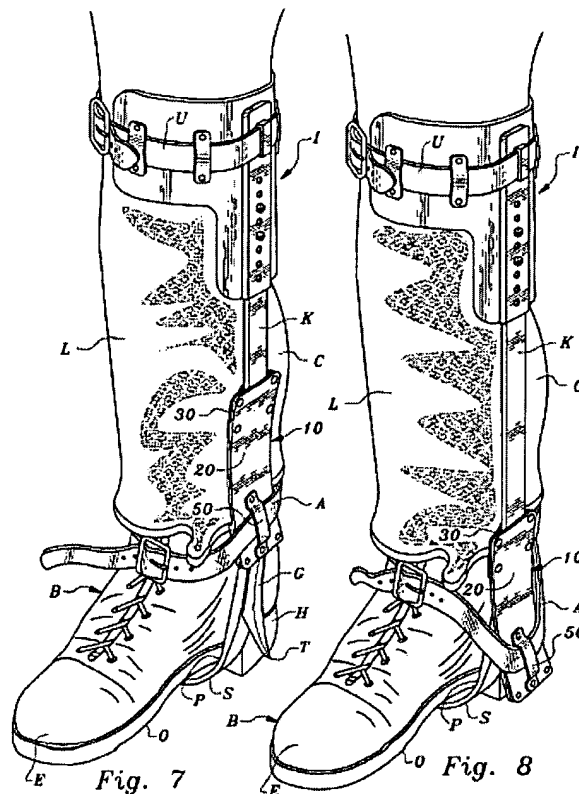
Claim Rejections under 35 U.S.C. § 102

Claims 1-4, 6-15 and 17-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,148,959 to Shay. Applicant respectfully traverses the rejection.

Shay describes a guard for covering and protecting a climbing gaff of a lineman's climbing iron. (*Shay*, abstract). The purpose of the Shay gaff guard is to cover and guard the gaff of a climbing iron to prevent dulling of the gaff or injury to others while the climbing iron is not being used to climb a wooden pole or tree. (*Shay*, col. 2, lines 48-52). The gaff guard consists of four main elements, all of which are preferably made of leather: a vertically-elongated base member, a smaller rectangular shank strap, a shank member, and an ankle belt strap. The shank strap attaches to an upper portion of the base member to form a collar to slidably connect the guard to a shank of the climbing iron. The sheath member attaches to a lower portion of the base member to form a pocket, which is sized to receive and protect the gaff of the climbing iron. Finally, the ankle belt strap attaches to the lower portion of the base member on a side that is opposite the sheath member, thereby forming a loop where an ankle belt of the climbing iron can be routed through. (*Shay*, col. 4, lines 51-67).

Because of the structure described above, the Shay gaff guard can be utilized in three ways: a stored mode, a walking mode, and a climbing mode. The

1 stored mode is used when the climbing iron is not on the lineman's leg, and the
 2 gaff guard is manipulated so as to cover and protect the gaff. In the walking
 3 mode, the gaff guard is also manipulated to cover the gaff, although the lineman is
 4 wearing the climbing device in this mode. Finally, the climbing mode is utilized
 5 as a lineman climbs a wooden pole. In the climbing mode, the gaff guard is
 6 secured so as to expose the gaff and allow the lineman to elevate the pole. (Shay,
 7 col. 3, lines 14-39). The gaff guard is easily understood with reference to Shay's
 8 Figs. 7 and 8, depicted below:



22 Fig. 7 shows the gaff guard in climbing mode, as is shown by the exposed
 23 gaff G. In Fig. 8, meanwhile, the gaff is positioned in the pocket of the gaff guard,
 24 which is positioned in walking mode.

1 **Independent claim 1** recites an apparatus, comprising:

2 a shield having a vertical portion sized to receive and protect at least
3 a portion of a leg and a horizontal portion sized to receive and protect at
4 least a portion of a foot, said shield removably positionable within at least a
5 portion of a gaffed climbing apparatus.

6 In making out a rejection of claim 1, the Office states the following:

7 Shay, as best seen in Figures 1, 3, 5, and 7, discloses a gaff assembly
8 comprised of a padded upper vertical portion having convex and concave surfaces, lower
9 horizontal portions A, 20, 30, 40, all protecting portions of a user's foot area, gaff/hook G, spike
10 T, strap/belt assembly U, and a plurality of fasteners 12, (some unnumbered) seen in Figure 5,
11 and as recited in column 8, lines 64-65, the fasteners can be VELCRO.

12
13 (Office Action of 08/19/05, p. 3). Applicant traverses the rejection for two
14 reasons: (1) the Office fails to state a *prima facie* case of anticipation, and (2) the
15 Shay reference, as a whole, fails to disclose all of the elements of Applicant's
16 claim.

17 In stating that Shay anticipates, the Office fails to actually state that Shay
18 discloses the language of Applicant's claims. For example, Claim 1 recites, in
19 part, "a shield having a vertical portion sized to receive and protect at least a
20 portion of a leg and a horizontal portion sized to receive and protect at least a
21 portion of a foot, said shield removably positionable". In the Action, the Office
22 does not show where Shay discloses "a vertical portion *sized to receive* and protect
23 at least a portion of a leg". (emphasis added). Similarly, the Office does not show
24 where Shay discloses "a horizontal portion *sized to receive* and protect at least a
25

1 portion of a foot”. (emphasis added). Nor does the Office show where Shay
2 teaches a shield that is “removably positionable”. Because the Office has failed to
3 show that Shay discloses all of the elements of Applicant’s claim 1, Applicant
4 respectfully submits that a *prima facie* case of anticipation has not been made.

5 For at least this reason, claim 1 is allowable over Shay.

6 Furthermore, Applicant respectfully submits that Shay, as a whole, does not
7 anticipate and therefore a valid *prima facie* case cannot be shown. As described in
8 detail above, Shay describes a *gaff guard*, intended to “cover and guard the gaff of
9 a climbing iron to prevent dulling of the gaff or injury to others while the climbing
10 iron is not being used to climb a wooden pole or tree.” (*Shay*, col. 2, lines 48-52).
11 While a lineman wears a climbing iron, the gaff guard can either be positioned in
12 over the gaff (i.e. in the walking mode) or above the gaff, so as to leave the gaff
13 exposed (i.e. in the climbing mode). The Shay gaff guard, however, does not
14 disclose the elements of Applicant’s claim 1.

15 For example, the Office cites a “padded upper vertical portion” of Shay as
16 disclosing “a vertical portion [of the shield] sized to receive and protect at least a
17 portion of a leg”, as recited in claim 1. Applicant submits, however, that the
18 “padded upper vertical portion” cited by the Examiner is not part of the Shay
19 invention at all, but rather is part of a conventional climbing iron, to which the
20 Shay gaff guard attaches. Meanwhile, Applicant’s claim 1 recites, in part, “a
21 shield having a vertical portion . . . , said shield *removably positionable within at*
22 *least a portion of a gaffed climbing apparatus.*” (emphasis added). Because the
23 element cited by the Office is part of the gaffed climbing apparatus, this element
24 cannot be said to be “positionable within . . . [the] gaffed climbing apparatus.” As
25 such, this element cannot be said to anticipate Applicant’s claim.

1 Similarly, Applicant's claim 1 recites "a horizontal portion sized to receive
2 and protect at least a portion of a foot". The Office cites Shay's elements "A, 20,
3 30, and 40" as disclosing this element of Applicant's claim. Applicant
4 respectfully submits, however, that these elements of Shay do not disclose
5 Applicant's "horizontal portion". First element A of Shay describes an ankle belt
6 that connects the lineman's ankle to the gaffed climbing iron. Again, this ankle
7 belt is part of the climbing iron itself. Therefore, the ankle belt cannot be said to
8 disclose "a shield having a . . . horizontal portion . . . , said shield *removably*
9 *positionable within at least a portion of a gaffed climbing apparatus.*" (emphasis
10 added). Furthermore, Applicant submits that an ankle belt configured to attach the
11 climbing iron to the lineman's ankle is not a "shield . . . sized to . . . *protect* at least
12 a portion of a foot" as described in Applicant's claim 1. (emphasis added).

13 Secondly, Shay's elements 20, 30 and 40 suffer from a similar infirmity.
14 These numbers correspond to the shank strap, the sheath member, and the ankle
15 strap, respectively, all of which are described in detail above. These three
16 elements, coupled with the base member, *form the gaff guard* depicted and
17 described above. Accordingly, Applicant submits that these elements, nor the gaff
18 guard as a whole, constitute a "horizontal portion [of a shield] sized to receive and
19 protect at least a portion of a foot". The gaff guard does not function to "receive .
20 . . a portion of a foot". To the contrary, the guard functions to receive the gaff
21 itself. Furthermore, as shown above in Figs. 7 and 8, the gaff guard is positioned
22 on the outside of the climbing iron, in order to accommodate the gaff. As such,
23 the gaff guard, as cited by the Office, cannot be said to form a portion of a "shield
24 [that is] *removably positionable within at least a portion of a gaffed climbing*
25 *apparatus.*" (emphasis added).

1 For at least this additional reason, claim 1 is allowable over Shay.
2 Applicant therefore respectfully requests that the §102 rejection be withdrawn.

3 **Dependent claims 2-4, and 6-10** depend from claim 1 and are allowable
4 by virtue of this dependency. Moreover, these claims recite features that, when
5 taken together with those of claim 1, define devices not disclosed by Shay.

6 **Independent claim 11** recites an apparatus, comprising:

7 a hook member;

8 a spike member connected to said hook member; and

9 a shield member having a vertical portion sized to receive and
10 protect at least a portion of a leg and a horizontal portion sized to receive
11 and protect at least a portion of a foot, said shield member connected to
said hook member.

12 For the reasons given above with respect to claim 1, Shay does not disclose
13 this apparatus. Namely, Shay does not disclose “a horizontal portion sized to
14 receive and protect at least a portion of a foot”.

15 Applicant therefore respectfully requests allowance of claim 11.

16 **Dependent claims 12-15 and 17-18** depend from claim 11 and are
17 allowable by virtue of this dependency. Moreover, these claims recite features
18 that, when taken together with those of claim 11, define devices not disclosed by
19 Shay.

20 **Independent claim 19** recites an apparatus, comprising:

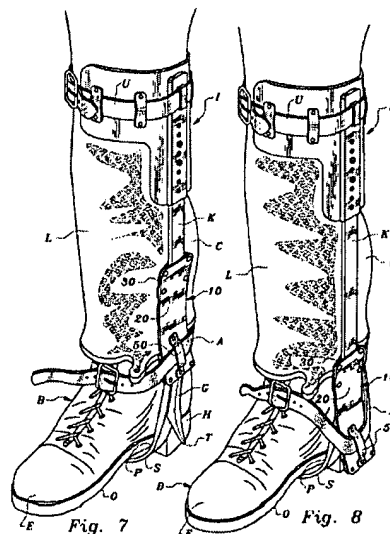
21 vertical shielding means for protecting at least a portion of a leg;
22 and

23 horizontal shielding means for protecting at least a portion of a foot,
24 said vertical shielding means connected to said horizontal shielding means,
25 said vertical shielding means sized to receive at least a portion of a leg and
said horizontal shielding means sized to receive at least a portion of a foot,

said vertical and horizontal shielding means removably positionable within at least a portion of a gaffed climbing apparatus.

For the reasons given above with respect to claim 1, Shay does not disclose this apparatus. Namely, Shay does not disclose “horizontal shielding means for protecting at least a portion of a foot . . . [and] sized to receive at least a portion of a foot”, nor does Shay disclose “vertical and horizontal shielding means removably positionable *within* at least a portion of a gaffed climbing apparatus.” (emphasis added).

Furthermore, Applicant submits that Shay does not disclose “vertical shielding means connected to . . . horizontal shielding means”. Again, the Office cites the “padded upper vertical portion” of Shay as Applicant’s “vertical shielding means”. The Office further cites the Shay gaff guard (elements 20, 30 and 40) and the climbing iron ankle belt (element A) as Applicant’s “horizontal shielding means”. (*Office Action of 08/19/05*, p. 3). Applicant submits, however, that the “padded upper vertical portion” of Shay and the gaff guard and ankle belt of Shay are not “connected”, as recited in Applicant’s claim 19. Figs. 7 and 8 of Shay display this infirmity, and are again reproduced below.



1 For at least this additional reason, claim 19 is allowable. Applicant
2 therefore respectfully requests allowance of claim 19.

3 **Dependent claim 20** depends from claim 19 and is allowable by virtue of
4 this dependency. Moreover, this claim recites features that, when taken together
5 with those of claim 19, define a device not disclosed by Shay.

6
7 **Claim Rejections under 35 U.S.C. § 103**

8 Claims 5 and 16 stand rejected under 35 U.S.C. § 103(a) as being
9 unpatentable over Shay as applied to claims 1-4, 6-15, and 17-20 above, and in
10 further view of U.S Patent No. 4,903,349 to Arai.

11 In making out a rejection of these claims, the Office cites Shay as teaching
12 all of the elements of independent claims 1 and 11. The Office then cites Arai as
13 teaching “the utility of magnetic fasteners”. The Office then states that it would
14 have been obvious to one of ordinary skill in the art to combine the references “as
15 a matter of engineering design choice”. (*Office Action of 08/19/05*, p. 3-4).
16 Applicant respectfully traverses the rejections.

17 Arai describes a helmet with a chin strap to secure it to a user’s head. The
18 chin strap is comprised of a retainer strap having a fastening member and an
19 operational band intended to be tightly fastened through the fastening member of
20 the retainer strap. (*Arai*, abstract).

21 For the reasons discussed above, Applicant respectfully submits that Shay
22 does not teach or suggest all of the elements of Applicant’s base claims 1 and 11.
23 Namely, Shay does not teach or suggest a “shield . . . [that is] removably
24 positionable within at least a portion of a gaffed climbing apparatus.”
25 Furthermore, Shay does not teach or suggest “a vertical portion sized to receive

1 and protect at least a portion of a leg”, nor does Shay teach or suggest “a
2 horizontal portion sized to receive and protect at least a portion of a foot”.
3 Furthermore, the Office does not cite Arai as teaching these elements, nor does
4 Arai as a whole teach or suggest any of these elements.

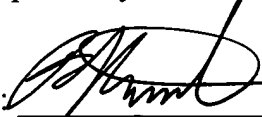
5 Base claims 1 and 11 are therefore not taught or suggested by the
6 combination of Shay and Arai for at least the reasons discussed above. Claims 5
7 and 16 are therefore allowable by virtue of this dependency, and Applicant
8 respectfully requests allowance of these claims. Moreover, these claims recite
9 features that, when taken together with those of claims 1 and 11, define devices
10 not disclosed by Shay.

11
12 **Conclusion**

13 Claims 1-20 are in condition for allowance. Applicant respectfully requests
14 reconsideration and prompt allowance of the subject application. If any issue
15 remains unresolved that would prevent allowance of this case, the Examiner is
16 requested to contact the undersigned attorney to resolve the issue.

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19 Date: 21 NOV 05

Respectfully Submitted,

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